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23630	7590	08/17/2010	EXAMINER	
McDermott Will & Emery 600 13th Street, NW Washington, DC 20005-3096			HAMMOND III, THOMAS M	
			ART UNIT	PAPER NUMBER
			3695	
			NOTIFICATION DATE	DELIVERY MODE
			08/17/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mweipdocket@mwe.com

Office Action Summary

Application No.

10/519,907

Applicant(s)

COURSE ET AL.

Examiner

THOMAS M. HAMMOND III

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 15-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-294)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Status of Claims

1. This Office Action is responsive to the Applicant's response filed 06 July 2010.
2. Claims 1 and 4-7 have been amended.
3. Claims 15-26 are withdrawn
4. Claims 1-14 are currently pending and have been examined

Information Disclosure Statement

5. The Information Disclosure Statements filed 12 July 2010 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Response to Arguments

6. **Claim Rejections - 35 USC § 112**

7. Claims 1, 4, 6, 10, and 12-14 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner appreciates the Applicant's prompt attention to these deficiencies and hereby withdraws such rejections.

8. **Claim Rejections - 35 USC § 102 & 103**

9. The Applicant's arguments are considered moot in view of the new grounds of rejection supplied by the Applicant from the IDS submissions on 12 July 2010.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 5-8, and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by **Walker et al., US Patent 6,381,582, (hereinafter “Walker”).**

As per claim 1

Walker teaches:

- entering into an agreement with the commercial provider to provide a good or service to a potential customer of the merchant for valuable or other consideration (see at least C9/L19-32)
- entering into an agreement with the merchant to offer the good or service of the commercial provider to its customers for valuable or other consideration (see at least C9/L19-32)
- electronically transacting with the customer of the merchant the provision of the good or service of the commercial provider to the customer (see at least C10/L4-41)
- using an electronic payment system to handle payment of a good or service of the commercial provider purchased by a customer of the merchant (see at least C10/L51-62)
- electronically authorizing the provision of the good or service of the commercial provider upon confirmation of payment by the electronic payment system (see at least C12/L13-57)
- electronically distributing the valuable consideration in respect of the payment to the commercial provider in accordance with the agreement made with the commercial provider (see at least C9/L19-32)

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- electronically distributing the valuable consideration in respect of the payment to the merchant in accordance with the agreement made with the merchant (see at least C9/L19-32)

As per claim 5

Walker teaches the method of claim 1 or 4, as shown above.

Walker further teaches:

- wherein the terminal device is one of an EFT terminal, a mobile telephone or portable digital assistant (see at least C5/L64-C6/L32)

As per claim 6

Walker teaches the method of claim 5, as shown above.

Walker further teaches:

- wherein the terminal device is the EFT terminal and the primary payment for the good or service is paid for by way of an electronic transfer of funds from the payment system associated with the EFT terminal (see at least C12/L61-67)

As per claim 7

Walker teaches the method of claims 1 or 4, as shown above.

Walker further teaches:

- wherein the provider of the electronic authorizing to the commercial provider for the provision of the good or service, the provider of the electronic transacting with the customer for the provision of the good or service to the customer, and the provider of the electronic distributing of the valuable consideration to the commercial provider and the merchant, if applicable, with the payment system, is the same provider (see at least C12/L12-57)

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As per claim 8

Walker teaches the method of claim 7, as shown above.

Walker further teaches:

- wherein the provider contracts with the merchant to pay the merchant a sales commission for a good or service that the merchant is able to sell or provide to a customer (see at least C9/L19-32)

As per claim 10

Walker teaches the method of claim 7, as shown above.

Walker further teaches:

- wherein the primary payment for the provision of a good or service is paid for by way of an electronic transfer of funds from a payment system associated with the business broker (see at least C12/L59-67)

As per claim 11

Walker teaches the method of claim 1 or 4, as shown above.

Walker further teaches:

- wherein primary payment for the service or product may be paid for directly by the customer (see at least C12/L39-57)

As per claim 12

Walker teaches the method of claim 6, as shown above.

Walker further teaches:

- the terminal device communicating the particular manner of the transacting payment to the provider, and the provider effecting the electronic distribution of the prescribed proportion based on the manner of such payment (see at least C12/L59-67)

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As per claim 13

Walker teaches the method of claim 10, as shown above.

Walker further teaches:

- including the terminal device communicating the particular manner of the transacting payment to the provider, and the provider effecting the electronic distribution of the prescribed portion based on the manner of such payment (see at least C12/L59-67)

As per claim 14

Walker teaches the method of claim 10, as shown above.

Walker further teaches:

- the terminal device communicating the particular manner of the transacting payment to the provider, and the provider effecting the electronic distribution of the prescribed portion based on the manner of such payment (see at least C12/L59-67)

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2 and 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of **Applicant's Admitted Prior Art (hereinafter "AAPA")**.

As per claim 2

Walker teaches the method of claim 1, as shown above.

Walker further teaches:

- electronically distributing the prescribed proportion or fixed sum of the payment to the entities in accordance with the agreement made with the entities (see at least C9/L19-32)

Walker does not teach:

- entering into an agreement with a sponsor of a terminal device of the electronic payment system to use the terminal device in handling payment for a good or service of the commercial provider purchased by a customer of the merchant, agreement being provided in return for a prescribed proportion of the price of the good or service or fixed sum

AAPA teaches:

- entering into an agreement with a sponsor of a terminal device of the electronic payment system to use the terminal device in handling payment for a good or service of the commercial provider purchased by a customer of the merchant, agreement being provided in return for a prescribed proportion of the price of the good or service or fixed sum

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include the third-party sponsor entity of a terminal device which agrees to be provided a fee for its services with the tri-party

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transaction system of Walker. One would have been motivated to do so in order to facilitate a payment for remotely purchased goods at a local POS system (see at least Walker C3/L58-60). Furthermore, the Supreme Court has supported in, *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), that merely combining well known elements, using well known methods, to yield a predictable result does not render an invention patentably distinct over such combination. In the instant case, the Applicant's admission that third party sponsors are well known entities in the transaction process is evidence that the technology to include such feature in the transaction process of O'Leary is also well known. The result of such combination would be predictable because the principal functionality of O'Leary is not changed by adding a third party sponsor in the transaction process. Accordingly, the claimed invention is obvious over Walker/AAPA.

As per claim 4

Claim 4, as best understood by the Examiner, encompasses the same or substantially the same scope as claim 2. Accordingly, claim 4 is rejected in the same or substantially the same manner as claim 2.

14. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of OFFICIAL NOTICE.

As per claim 3

Walker teaches the method of claim 1, as shown above.

Walker does not teach:

- where the step of using an electronic payment system to handle payment of a good or service of the commercial provider purchased by a customer of the merchant includes the sub-step of electronically drawing on an electronic bank account of the merchant to pay for the good or service of the commercial provider purchased by the customer

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However, the Examiner has previously taken OFFICIAL NOTICE that drawing on an electronic bank account of a merchant to pay for the good or service of the commercial provider purchased by the customer is old and well known. The Examiner further asserts that the Applicant has not properly challenged such statement of OFFICIAL NOTICE, therefore rendering such statement prior art of record, henceforth.

As per claim 9

Walker/OFFICIAL NOTICE teaches the method of claim 7, as shown above.

Walker does not teach:

- wherein the merchant pays a fee to the provider for the provision of a good or service that adds value to the merchant's business

However, the Examiner has previously taken OFFICIAL NOTICE that agreements to pay fees or sales commissions is old and well known in the business arts. The Examiner further asserts that the Applicant has not properly challenged such statement of OFFICIAL NOTICE, therefore rendering such statement prior art of record, henceforth.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Hammond III whose telephone number is 571-270-1829. The examiner can normally be reached Monday - Friday, 7AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.